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EXAMINER

MACKEY, JAMES P

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/783,892

Applicant(s)

HOWE ET AL.

Examiner

James Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 May 2003 has been entered.

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-22 (presented in the amendment filed on 08 May 2003) have been renumbered as claims 14-35.

3. Applicant is required to correct the claim dependencies to agree with this claim renumbering. While the amendment filed on 08 May 2003 states in the Remarks (at page "20") that "Applicants herein ... replace claims 1-7 and 9-13 with claims 1-22", no clear request to cancel claims 1-7 and 9-13 has been made; therefore, pending claims 1-7 and 9-13 remain pending in this application. As noted above, the new claims have been renumbered as claims 14-35.

4. The amendment filed 08 May 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

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a) on page 4, line 8, the addition of a “ribbon” being cut away is new matter unsupported by the original disclosure;

b) on page 4, line 17, the deletion of “and forms it into the desired shape and size for the serving” is considered to be new matter in that it changes the content and meaning of the original disclosure;

c) on page 5, lines 6-9, the deletion of the serving portions being controlled by “the size of the channel in the scoop” and “the forming and dispensing means” is considered to be new matter in that it changes the content and meaning of the original specification;

d) on page 7, lines 12-13, the addition of the product emerging through the opening of the scoop “in a generally spherical shape” is new matter unsupported by the original disclosure; and

e) on page 11, lines 20-21, the deletion of “the cross-sectional area of the channel, the forming and dispensing means” as factors in controlling the amount of product dispensed, is considered to be new matter in that it changes the content and meaning of the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 14-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In claim 14, lines 9-10, the product “rolled back on itself into a spherical shape” lacks support in the original disclosure.

In claim 14, lines 13-14, the collection compartment having “at least a partially closed portion directed towards said first side of said removal portion” lacks support in the original disclosure.

In claim 15, lines 3-5, the collection component “having a shape generally conformable to said interior wall of said collection compartment” and “positionable during its operation to generally abut at least a portion of said interior wall” both lack support in the original disclosure.

In claim 15, line 10, the operator actuatable assembly being “responsive to operator input” lacks support in the original disclosure.

In claim 16, the retrieval arm being “spirally shaped” lacks support in the original disclosure (the arm is disclosed as being “curved” in the original disclosure).

In claim 19, lines 1+, the collection component including “a flexible member connected along at least a portion of its periphery to said interior wall of said collection compartment to abut said interior wall when in a static condition” lacks support in the original disclosure.

In claim 23, the leading edge being “a knife shaped edge” lacks support in the original disclosure.

In claim 30, line 4, “extend generally spirally” lacks support in the original disclosure.

In claim 30, lines 13-14, the collection compartment including “a closed side adjacent the terminus of said trailing edge” lacks support in the original disclosure.

In claim 30, line 16, the “interior of said collection compartment having a generally spherical shape” lacks support in the original disclosure.

In claim 32, lines 2-3, the movable portion being “sized and configured to be brought into close abutment with at least a portion of said interior wall of said collection compartment” and lines 6-7, “into and away from close abutment with at least a portion of said interior wall of said collection compartment” both lack support in the original disclosure.

In claim 33, line 2, “a disc-like portion sized and dimensioned to cover a substantial portion of the open end of the ice cream container” lacks support in the original disclosure (note “platform 52” in Figure 5 has not been described as is now recited in claim 33).

In claim 35, the trailing edge having “a knife-like front edge” lacks support in the original disclosure.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 14-29 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, lines 14-15, “having an interior wall” is indefinite as to which structural element is being referred to; for purposes of examination, it will be assumed that the interior wall is a part of the collection compartment.

In claim 15, lines 11-12, “said closed side of said collection compartment” lacks proper antecedent basis in the claims (note that claim 14 refers to “at least a partially closed portion” at lines 13-14).

In claim 19, the structural relationship between the collection component and the “flexible member” is unclear and indefinite, such that the claim is incomplete for omitting

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essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

In claim 26, the claim should clarify that the channel being “generally semi-circular” refers to the cross-sectional shape of the channel.

Claims 28 and 29 should both depend from claim 15 (rather than claim 14) in order to provide proper antecedent basis for “said dispensing portion” and “said collection component”.

In claim 34, lines 3-4, “said retrieving portion” lacks proper antecedent basis and should apparently be changed to --said removal portion--.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-7 and 9-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Whiteside (U.S. Patent 1,638,134), **for the reasons of record** as described in the previous Office Action, Paper No. 8.

11. Claims 14-17, 20, 22-26, 30-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Whiteside (U.S. Patent 1,638,134).

Whiteside teaches an ice cream dispensing assembly including a removal portion 18 having a lower first side disposed adjacent and perpendicular to the open end of a container B and extending into the container, a retrieval arm on the lower first side of the removal portion, the retrieval arm including a leading edge and a trailing edge 20 extending further than the leading edge (note that the trailing edge is considered to have a “knife shaped edge”, see page 1,

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line 106), a spiral tapered channel 19 having a semi-circular C-shaped cross-section defined between the leading and trailing edges, the channel having first and second ends, the first end positioned adjacent the wall of the container, the channel having an opening at the second end, the removal portion further including an integral collection compartment (at 19') having an open side at the upper second side of the removal portion, the collection compartment communicating with the opening of the channel, the collection compartment having an interior wall 19' of a generally spherical shape (to conform to the shape of scoop 23, see page 2, lines 21+), the collection compartment having at least a partially closed portion directed towards the lower first side of the removal portion, the ice cream dispensing assembly further including a dispensing portion including a movable collection component 23 having a shape generally conformable to the interior wall of the collection compartment (see page 2, lines 21+) and an operator actuatable assembly 25 connected to the dispensing portion to position the collection component relative to the interior wall of the collection compartment. The ice cream dispensing assembly further includes means 17 for effecting rotation of the removal portion/dispensing assembly relative to the container. Whiteside further teaches that the removal portion 18 includes a "disc-like portion sized and dimensioned to cover a substantial portion" of the container open end (claim 33), and the dispensing portion is mounted above the disc-like portion (claim 34). Note that intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530; the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235; a recitation with respect to the manner in which a claimed apparatus is intended to be employed



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does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 18, 21 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiteside (U.S. Patent 1,638,134).

Whiteside discloses an ice cream dispensing assembly substantially as claimed, as described above, except for the removal portion/collection compartment being a molded plastic unit (claim 18), except for means to rotate the container while holding the dispensing assembly stationary (claim 21), except for a heating element in the removal portion (claim 27) or the dispensing portion (claim 28), and except for a non-stick coating on the various elements of the removal portion (claim 29). However, plastic food handling equipment and food handling equipment having non-stick coatings are notoriously well known in the food industry, and it

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would have been obvious to one of ordinary skill in the art at the time of the invention to modify Whiteside by providing the removal portion (including the integral collection compartment) as being formed of plastic or as having a non-stick coating, since such are notoriously well known in the food industry for food handling equipment and since such facilitates the handling of the food as well as meeting the sanitary requirements of the food industry. With regard to the means to rotate the container while holding the dispensing assembly stationary, Whiteside discloses means to rotate the dispensing assembly while holding the container stationary for providing a relative rotation therebetween, and a skilled artisan would have readily recognized that rotation of either the dispensing assembly or the container would provide such relative rotation and therefore it would have been obvious to a skilled artisan to have provided Whiteside with means to rotate the container, since such would provide the required relative rotation of the dispensing assembly and container, since such were equivalent to the dispensing assembly rotation means of Whiteside, and since such amounts to the mere reversal of parts, which has been held to be within the general level of skill of an ordinary artisan, see *In re Gazda*, 104 USPQ 400, and *In re Japikse*, 86 USPQ 70. With regard to the heating element for either the removal portion or the dispensing portion, ice cream dispensing apparatus having heating elements for facilitating the removal of the shaped ice cream therefrom is notoriously well known in the ice cream dispensing art, and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Whiteside by providing either the removal portion or the dispensing portion with such conventional heating elements in order to facilitate the removal of the shaped ice cream therefrom.

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15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maddux (U.S. Patent 2,534,782) and Spirk et al. (U.S. Patent 4,796,784) disclose ice cream dispensing assemblies including a container, a removal portion having protruding shearing edges (element 31 in Maddux; element 48 in Spirk et al.), and means to cause a relative rotation between the container and the removal portion.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 703-308-1195. The examiner can normally be reached on M-F, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
James Mackey  
Primary Examiner  
Art Unit 1722  
7/28/03

jpm  
July 28, 2003